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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/425,027 | 10/25/1999 | TAKASHI SHIMIZU | 104610 | 8990 |

25944 7590 04/24/2002

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| EXAMINER |
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ZIRKER, DANIEL R

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| ART UNIT | PAPER NUMBER |
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1771

DATE MAILED: 04/24/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.



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DATE MAILED:

Below is a communication from the EXAMINER in charge of this application
COMMISSIONER OF PATENTS AND TRADEMARKS

ADVISORY ACTION

THE REPLY FILED FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.
Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check only a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ In view of the early submission of the proposed reply (within two months as set forth in MPEP § 707.07(f)), the period for reply expires on the mailing date of this Advisory Action, OR continues to run from the mailing date of the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will be entered upon the timely submission of a Notice of Appeal and Appeal Brief with requisite fees.
3. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search. (see NOTE below);
- (b) ☒ they raise the issue of new matter. (see NOTE below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE:

See attached NOTE.

4. ☒ Applicant's reply has overcome the following rejection(s):
35 USC 112, 2nd paragraph rejections of record (if it was entered)
5. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
6. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See attached NOTE.
7. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
8. ☒ For purposes of Appeal, the status of the claim(s) is as follows (see attached written explanation, if any):
- Claim(s) allowed: None
- Claim(s) objected to: None
- Claim(s) rejected: 1-3, 7-11
- Claim(s) withdrawn from consideration: 4-6
9. ☐ The proposed drawing correction filed on _____ a) ☐ has b) ☐ has not been approved by the Examiner.
10. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
11. ☐ Other: _____

DANIEL ZIRKER
PRIMARY EXAMINER
GROUP 4388

Daniel Zinker

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NOTE

With respect to applicants' After Final Response of April 12, 2002, the following observations are deemed to be pertinent:

1. The amendment to claim 1 regarding "bonding the whole surface hot melt adhesive" is both a "new issue" and also appears to be "new matter". There is not believed to be an express teaching of bonding the "whole surface" of the web-like hot melt adhesive to thDe film-like hot melt adhesive found in the specification (not at, e.g. page 4, lines 17-23), and no inherent support has been found to exist (as in, e.g., the Drawings).

2. The amendments to claims 1 and 4 regarding the limitation "substantially free of trapped air bubbles" is both a "new issue" and also clearly appears to be "new matter". There is no express teaching of such a limitation in the specification (not at, e.g., page 5, lines 2-4 or page 8, line 25 - page 9, line 3) and, most seriously, such a limitation also violates the rule of Ex parte Grasselli et al. 231 USPQ 393, affirmed 738 F. 2d 453 (Fed. Cir. 1984) that amended limitations such as "free of" a certain element are "new matter".

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3. Applicants are again encouraged to (if possible) file a CIP which would contain a suitable comparison along the line such as is argued on page 7 of their Response against the prior art structures that are taught as inferior.

Dzirker:cdc

(703) 308-0031

April 19, 2002